

REMARKS

Claims 1-20 are pending in the application upon entry of the amendments and new claims. Claims - have been amended for consistency and to better describe certain aspects of the invention. Claims - have been added to further describe the invention. Claim - has been cancelled. Favorable reconsideration in light of the amendments, the new claims, and the remarks which follow is respectfully requested.

The Allowable Subject Matter

The Examiner's indication that claims 11-14 contain allowable subject matter is noted with appreciation.

The Obviousness Type Double Patenting Rejection

Claims 1-20 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of Speronello et al (U.S. Patent 6,294,108). The subject application and Speronello et al are owned by the same entity; namely, Engelhard Corporation. The enclosed Terminal Disclaimer renders this rejection moot.

The Obviousness Rejection

Claims 1-10, 15-20 have been rejected under 35 U.S.C. §103(a) over Wellinghoff (U.S. Patent 5,631,300). Wellinghoff relates to a biocidal composition providing the sustained release of chlorine dioxide. The composition contains a hydrophilic material (source of chlorite anions) and a hydrophobic material (acid releasing agent hydrolyzable by moisture, such as an acid releasing wax). Hydrophobic materials of Wellinghoff are described in detail in Columns 9 and 10. In operation, acid is released from the hydrophobic material after moisture contacts the hydrophobic material, and the released acid reacts with the hydrophilic material to generate chlorine dioxide.

The Examiner contends that it would have been obvious to select any combination of the compounds of Wellinghoff to arrive at the claimed invention. The Examiner also

contends that the language "consisting essentially of" language of the claims does not exclude the presence of hydrophobic material in the composition. Applicants respectfully disagree.

As noted by MPEP § 2111.03, the transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components, if any, are excluded from the scope of the claim. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

The chlorine dioxide generating composition of Wellinghoff contains a hydrophobic material containing an acid releasing agent, such as carboxylic acids, esters, anhydrides, acyl halides, phosphoric acid, phosphate esters, dialkyl phosphates, sulfonic acid, sulfonic acid esters, sulfonic acid chlorides, and phosphosilanes of glycol based esters (see Col. 9, lines 1-5).

The presence of the hydrophobic material containing an acid releasing agent of Wellinghoff would materially affect the basic and novel characteristics of the claimed invention. The claimed invention employs a hydrophilic material to achieve a sustained release of chlorine dioxide for an extended period of time. The presence of the hydrophobic material containing an acid releasing agent of Wellinghoff would dramatically increase the rate and amount of chlorine dioxide generated (greater amount generated over a shorter period of time), thus making the composition inappropriate for many uses contemplated by the claimed invention. Decreasing the sustained release aspect of the claimed invention is a material change to the basic and novel characteristics of the claimed invention.

Therefore, the transitional phrase "consisting essentially of" specifically limits the scope of the claims to the metal chlorite and the hydrophilic material. The hydrophobic acid releasing agent of Wellinghoff is excluded from the claims by the transitional phrase "consisting essentially of". For at least these reasons, Wellinghoff cannot render the

claims obvious. Withdrawal of the rejection is consequently respectfully requested.

Petition for Extension of Time

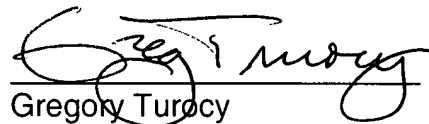
A petition and request for a three month extension of time is hereby made. A Credit Card charge form is enclosed herewith to pay the petition fees.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-1063.

Respectfully submitted,

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